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No. 93-862

In the

Supreme Court of the United States

October Term, 1993

BELLSOUTH ADVERTISING AND PUBLISHING CORPORATION,

Petitioner,

v.

DONNELLEY INFORMATION PUBLISHING, INC., and THE REUBEN H. DONNELLEY CORPORATION,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE ELEVENTH CIRCUIT

MOTION FOR LEAVE TO FILE BRIEF AND BRIEF OF WEST PUBLISHING COMPANY AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER BELLSOUTH'S PETITION FOR A WRIT OF CERTIORARI

JAMES E. SCHATZ
Counsel of Record
Bradley W. Anderson
Joseph M. Musilek
HEINS SCHATZ & PAQUIN
2200 Washington Square
100 Washington Avenue South
Minneapolis, Minnesota 55401
(612) 339-6900

Counsel for West Publishing Company

1993 — Bachman Legal Printing ■ (612) 339-9518 ■ FAX (612) 337-8053

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Bellsouth Advertising And Publishing Corporation,
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v.

Donnelley Information Publishing, Inc., and
The Reuben H. Donnelley Corporation,
Respondents,

On Petition for Writ of Certiorari to the
United States Court of Appeals
for the Eleventh Circuit

MOTION OF WEST PUBLISHING COMPANY FOR LEAVE TO FILE A BRIEF IN SUPPORT OF PETITION OF BELLSOUTH ADVERTISING AND PUBLISHING CORPORATION FOR A WRIT OF CERTIORARI

West Publishing Company respectfully moves for leave to file the accompanying brief Amicus Curiae pursuant to Rule 37.4 of the Supreme Court Rules. Petitioner granted West written permission to serve an Amicus brief, but respondents denied West's request for permission, necessitating this motion.

Interest of Amicus Curiae

West is the leading American publisher of law-related compilations and has over 100 years experience preparing copyrighted compilations and protecting those compilations from infringement. West recently introduced West's Legal Directory, a WESTLAW database service that contains profiles of attorneys and law firms. Like BAPCO, West has selected and arranged the information in West's Legal Directory in a wide and creatively conceived variety of categories, including not only name and geographic location, but also size of firm, practice specialties, practice concentrations, representative clients and professional affiliations.

The Basis For West's Motion

West seeks leave to file an Amicus brief to highlight the need for this Court to grant certiorari in order to preserve the efficacy of this Court's recent decision in Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S.Ct. 1282 (1991) ("Feist"). The decision below is inconsistent with Feist and, if it is allowed to stand, will undercut this Court's guidance in an important area of copyright law.

Indeed, while BAPCO fully discusses the direct conflict among the circuits created by the decision below, and the potential effect of that decision on "yellow pages" directory publishers, West focuses its Amicus brief on the widespread application of Feist in non-telephone directory cases.

A WESTLAW search reveals that the lower federal courts already have cited Feist at least 49 times, but that very few of those cases involved directories of any kind. The great majority of opinions in which Feist was cited involve

compilations that have nothing to do with telephone listings.[1] It is impossible to overstate the importance of Feist to every compilation publisher, and the need these publishers have for clear guidance from Feist.

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[1] See, e.g., Arica Institute, Inc. v. Palmer, 970 F.2d 1067, 1076 (2nd Cir. 1992) (sequence of labels in self-help training materials); Kregos v. Associated Press, 937 F.2d 700, 704 (2nd Cir. 1991) (baseball pitching form); Victor Lalli Enters. v. Big Red Apple, Inc., 936 F.2d 671, 673 (2nd Cir. 1991) (chart of winning numbers); Atari Games Corp. v. Oman, 979 F.2d 242, 245, 247 (D.C. Cir. 1992) (video game); Mason v. Montgomery Data, Inc., 967 F.2d 135, 141 (5th Cir. 1992) (real estate ownership maps); Schiller & Schmidt, Inc. v. Nordisco Corp., 969 F.2d 410, 413 (7th Cir. 1992) (business supply catalog); Financial Control Assocs. v. Equity Builders, 799 F.Supp. 1103, 1119 (D.Kan. 1992) (mortgage prepayment booklet); Budish v. Gordon, 784 F.Supp. 1320, 1333 (N.D. Ohio 1992) (tables of information on Medicaid); Khandji v. Keystone Resorts Management, Inc., 140 F.R.D. 697, 700 (D.Colo. 1992) (legal settlement brochure); Sem-Torq v. K Mart Corp., 936 F.2d 851 (6th Cir. 1991) (set of double-sided signs); Penelope v. Brown, 792 F.Supp. 132, 135, 139 (D.Mass. 1992) (compilation of English grammatical rules); Corsearch, Inc. v. Thomson & Thomson, 792 F. Supp. 305 (S.D.N.Y. 1992) (state trademark data); Lipton v. The Nature Co., 781 F.Supp. 1032, 1034 (S.D.N.Y. 1992) (Middle English "terms of venery").

Conclusion

Accordingly, West's Amicus brief is of value to the Court in weighing, in the broader context of all fact-based compilations, the reasons why it should grant certiorari in the case below. Therefore, West requests this Court grant West's motion and consider the following reasons set forth by West for granting BAPCO's petition.

Dated: December 28, 1993

Respectfully submitted,

James E. Schatz*
Bradley W. Anderson
Joseph M. Musilek
HEINS SCHATZ & PAQUIN
2200 Washington Square
100 Washington Avenue South
Minneapolis, MN 55401
(612) 339-6900
Counsel for West Publishing Company

*Counsel of Record

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BRIEF OF WEST PUBLISHING COMPANY AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER BELLSOUTH ADVERTISING AND PUBLISHING CORPORATION'S PETITION FOR A WRIT OF CERTIORARI

PRELIMINARY STATEMENT

West Publishing Company ("West") submits this brief as Amicus Curiae in support of Petitioner Bellsouth Advertising & Publishing Corporation ("BAPCO"), pursuant to Rule 37 of the Supreme Court Rules.

INTEREST OF AMICUS CURIAE

West is the leading American publisher of law-related compilations and has over 100 years experience preparing copyrighted compilations and protecting those compilations from infringement. West recently introduced West's Legal Directory, a WESTLAW database service that contains profiles of attorneys and law firms. Like BAPCO, West has selected and arranged the information in West's Legal Directory in a wide and creatively conceived variety of categories, including not only name and geographic location, but also size of firm, practice specialties, practice concentrations, representative clients and professional affiliations.

SUMMARY OF ARGUMENT

In Feist Publications, Inc. v. Rural Telephone Service Co., 499 U.S. 340, 111 S.Ct. 1282 (1991), this Court spoke in the clearest possible terms of the "minimal" level of creativity required to qualify a compilation for copyright protection, noting that, "choices as to selection and arrangement, so long as they are made independently by the compiler and entail a minimum degree of creativity, are sufficiently original that Congress may protect such compilations through the copyright laws." 111 S. Ct. at 1289. At least four different times in Feist, this Court emphasized this minimal quantum of originality required for copyright protection.[2] Despite this repeated emphasis, the Eleventh Circuit found that a classified directory representing substantial intellectual judgment, in both the selection of the business categories included in the directory and in the distribution of listing or entries among the selected categories, was not sufficiently original to merit copyright protection. Feist's mantra of "minimal creativity" obviously fell on deaf ears in the Eleventh Circuit.

The decision below not only misconstrues Feist, but this misapplication may substantially chill the creation and publication of a wide variety of compilations. If not corrected by this Court, the decision below may alter longstanding, fundamental principles of copyright law upon which West and many other publishers have relied in creating products. Further, the conflict between the circuits caused by the decision below will pose enormous hardships upon publishers of compilations that are distributed nationwide.

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[2] "To be sure, the requisite level of creativity is extremely low; even a slight amount will suffice." 111 S.Ct. at 1287; "[A] minimum degree of creativity" is sufficient. Id. at 1289; "[T]he originality requirement is not particularly stringent." Id. at 1294.; "[O]riginality is not a stringent standard" Id. at 1296.

ARGUMENT

I. THE CONFLICT BETWEEN THE CIRCUITS AS A RESULT OF THE DECISION BELOW WILL INHIBIT THE CREATION OF NEW AND USEFUL FACTUAL COMPILATIONS

As BAPCO notes in its petition, there is a direct conflict between the decision below and the decision of the Court of Appeals for the Second Circuit in Key Publications, Inc. v. Chinatown Today Publishing Enterprises, Inc., 945 F.2d 509 (2nd Cir. 1991) ("Key Publications"). The decision below also contradicts every decision on the protectibility of "yellow pages" and other classified directories rendered before Feist.[3]

This conflict is intolerable for three principal reasons: (1) the nationwide distribution of many factual compilations renders a circuit conflict particularly onerous; (2) the recency and parity of the decision below and Key Publications will cause great uncertainty in the law and great difficulty for the lower federal courts; and (3) the extreme importance of Feist in determining compilation copyright issues necessitates that its guidance to the lower federal courts not be muddied by conflicting lower court interpretations.

First, the conflict introduced by the decision below will make it difficult for publishers of nationwide directories to distribute their works. Given the current conflict, it is

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[3] See Southern Bell Telephone & Telegraph Co. v. Associated Directory Publishers, 756 F.2d 801 (11th Cir. 1985); J.R. O'Dwyer Company, Inc. v. Media Marketing International, Inc., 755 F. Supp. 599 (S.D.N.Y. 1991) (directory of public relations firms); Southwestern Bell Media, Inc. v. Trans Western Publishing, Inc., 670 F. Supp. 899 (D. Kan. 1987); Northwestern Bell Telephone Co. v. Bedco of Minnesota, Inc., 501 F. Supp. 299 (D. Minn. 1980); Central Telephone Company of Virginia v. Johnson Publishing Co., Inc., 526 F. Supp. 838 (D. Colo. 1981).

apparent that equivalent levels of selection, coordination and arrangement of data contained in nationally distributed directories will receive widely disparate copyright protection in the Second and Eleventh Circuits.[4] The specter of such uneven protection will inhibit the creation of classified-type directories and other types of compilations for the national market, or will, at the very least, inhibit distribution of such directories and compilations within the Eleventh Circuit.

A comparison of the editorial decisions undertaken by the BAPCO and Key Publications compilers shows that there is no way to reconcile the different results of the two cases. For example, both the Plaintiff in Key Publications and BAPCO sought to exclude from their classified directory businesses which they did not think would remain in operation. Key Publications, 945 F.2d at 513; Pet. Br. at 3-4. Similarly, both the Plaintiff in Key Publications and BAPCO included in their directories classified category headings which were often used in competing directories and included category headings which were not generally found in other classified directories. Key Publications at 514; Pet. Br. at 5, 18. Further, the Plaintiff in Key Publications selected and arranged its 9,000 business listings among approximately 260 different categories selected by it, while BAPCO selected and arranged its 106,398 listings among the 3,795 different classified headings selected by it. Key Publications at 514; Pet. Br. at 10.

Publishers are thus faced with two cases involving identical editorial decisions that cannot be distinguished. Indeed, it appears from the record that BAPCO made considerably more subjective editorial decisions in selecting, coordinating and arranging the data in its directory than did

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[4]For example, under the current state of the law, the West's Legal Directory database conceivably could be subject to different levels of copyright protection depending on whether it is accessed from New York or Atlanta.

the Plaintiff in Key Publications, yet the Eleventh Circuit held BAPCO's editorial decisions to be insufficiently creative.

A second reason the conflict generated by the decision below is intolerable is that both of the conflicting decisions are of recent post-Feist origin, with each ostensibly carrying full weight as precedential authority in this area. There exists no guidance for the district courts in determining which of these competing decisions to follow: one decision is by a Court of Appeals acknowledged to be a leader and guide in the area of copyright law, while the other is an en banc decision. The decisions in both cases were reached through application of this Court's most recent decision in this area, Feist, so there is no basis to distinguish the decisions on that grounds. In short, there is no principled means by which the lower federal courts can decide which of these conflicting decisions to follow. Absent resolution of the conflict by this Court, compilation publishers will face great and unacceptable uncertainty as to whether the selection, coordination and arrangement of data contained in their publications will be protected by copyright.

Finally, the conflict is intolerable because it will dilute and diminish the guidance of Feist, this Court's first decision construing the copyright protection afforded "compilations" under current copyright law.

Feist emphasizes again and again that compilations are not fundamentally different from other types of works. Indeed, the basic holding of Feist is that compilations are subject to the same requirement of originality that is applicable to other works. Thus, the discussion of originality in Feist is properly understood as governing the standard of copyrightability that must be met, not just by compilations, but by all works seeking copyright protection. Since Feist is the only recent exposition of the originality requirement by this Court, virtually every decision on copyrightability now ultimately turns on the Feist opinion. Any substantial misreading of Feist, such as the decision below, therefore, threatens to

distort the entire framework of copyright law.

The decision below is not merely an example of the inevitable differences of opinion that arise in the application of a subjective standard. The en banc decision of the Eleventh Circuit seriously misinterprets the governing legal standard.

In describing the plaintiff's "white pages" directory in Feist, this Court referred to it as "entirely typical," and as "a garden-variety white pages directory." 111 S. Ct. at 1296. The court below elevated these purely descriptive references to a legal standard of originality.

> While the listings in BAPCO's yellow pages required somewhat more organization and arrangement than the white pages directory considered in Feist, BAPCO's claim of originality must be resolved by comparison to other business telephone directories. BAPCO did not deviate from the arrangement of the typical business directory, which employs an alphabetical list of headings to describe various types of business and then alphabetizes the listing under the appropriate headings.

Pet. App. at 9a n.13.

The application of the originality standard in Feist, however, rests on the Court's assessment of the quality of intellectual contribution embodied in the creation of the plaintiff's compilation, not on a comparison with other works. Indeed, this Court emphasized repeatedly in Feist that the patent-like novelty requirement employed by the court below was not part of the originality standard. "Originality does not signify novelty; a work may be original even though it closely resembles other works so long as the similarity is fortuitous, not the result of copying." 111 S. Ct. at 1287; "A compiler may settle upon a selection or arrangement that others have used; novelty is not required." Id. at 1294; "[O]riginality . . .

does not require that facts be presented in an innovative or surprising way." Id. at 1296.

Thus, whereas this Court merely described the compilation being evaluated in Feist as "typical", the Eleventh Circuit has given independent substantive significance to the comparison with other compilations -- a significance that is directly at odds with this Court's own articulation of the applicable legal standard in Feist. Judge Hatchett, in his dissent below, recognized the majority's misreading of Feist: "In reasoning that BAPCO's selection of headings lack originality because many resemble NYPSA headings, the majority completely ignores the Feist Court's holding that an independent selection of data need not be "novel" in order to be deemed original," Pet. App. at 25a n.2.

The misinterpretation of Feist in the en banc decision below threatens to undermine the critical distinction between the standards of novelty and nonobviousness traditionally applicable to the grant of a patent and the much less stringent requirement of originality that is the governing standard of copyrightability.

For the above reasons, this conflict between the Second and Eleventh Circuits is not a "manageable" one; it is a crucial, intolerable conflict that will hamper the operations and business decisions of the nation's compilation publishers. Therefore, this conflict should be resolved by this Court granting BAPCO's petition and reversing the decision below.

II. THE DECISION BELOW PROVIDES THIS COURT WITH AN APPROPRIATE AND NECESSARY OPPORTUNITY TO CLARIFY THE SCOPE OF FEIST.

The decision below provides this Court with an appropriate opportunity to clarify Feist. That opportunity is all the more valuable because the discussion of compilation

copyrights in Feist was necessarily limited by the factual record in that case, i.e., "a garden variety white pages directory, devoid of even the slightest trace of creativity." Feist, 111 S.Ct. at 1296. The decision below, in contrast, involves a much more expansive factual record upon which to provide firmer guidance as to what constitutes the minimal creativity necessary for a compilation to be protected by copyright.[5] This Court stated in Feist that the "vast majority" of compilations will be sufficiently creative to be entitled to copyright protection. 111 S. Ct. at 1294. However, that statement may no longer be true if the Court allows the decision below to stand.

An important decision by this Court, such as Feist, in an area of law it has not previously addressed, often requires a subsequent, "bookend" decision to establish the parameters of the initial decision. For example, in Sony Corporation of America v. Universal City Studios, 464 U.S. 417, 104 S.Ct. 774 (1984) ("Sony"), the Court, for the first time, addressed the 1976 Copyright Act's "fair use" defense, holding that the taping of broadcast television programs for purposes of "time-shifting" was a fair use of the copyrighted works.

A year later, the Court accepted for review, and reversed, the Second Circuit's decision that a magazine's unauthorized publication of quotes from President Ford's memoirs was a "fair use" of the copyrighted book. Harper & Row, Publishers, Inc. v. Nation Enterprises, 471 U.S. 539, 105 S.Ct. 2218 (1985) ("Harper & Row"). Harper & Row provided the

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[5] In Feist, the compiler's selection of persons for inclusion in its directory was nothing more than its telephone-service subscriber list. Here, both parties agree that BAPCO included listings of businesses in its directory that were outside the geographic limits of BAPCO's corresponding white pages directory while also restricting the directory to companies with business telephone service. BAPCO also solicited selected national advertisers for inclusion in its yellow pages directory. See Pet. App. at 8a-10a.

Court with the opportunity to expand upon its fair use discussion in Sony by focusing on the different factual elements existing in the Harper & Row case. The result was a pair of fair use decisions that reached different results, but that have served together to settle much of the uncertainty over application of the fair use defense to a wide range of copyright infringement situations.[6]

Similarly, the decision below provides the Court with an opportunity to again provide bookends to a thorny area of copyright law -- the question of the level of creativity needed for a compilation to obtain copyright protection.[7] By taking this case, and reversing the Eleventh Circuit, this Court will give lower federal courts a substantial degree of certainty as they face future disputes involving the quantum of originality necessary to support a compilation copyright and the scope of protection accorded such a compilation.

In so ruling, this Court will have set forth and discussed

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[6]Thus, it is not surprising that a WESTLAW search of copyright cases decided subsequent to Sony and Harper & Row uncovered 63 reported decisions in which the two cases were discussed in tandem in evaluating an asserted fair use defense. For example, extensive use of the fair use analysis of both Sony and Harper & Row was made in the highly publicized fair use decision in Basic Books, Inc. v. Kinko's Graphics Corp., 758 F. Supp. 1522 (S.D.N.Y. 1991).

[7]This necessity to clarify an initial decision with cases presenting different sets of facts is a common occurrence. Another example occurred with the Court's interpretation of the Racketeer Influenced and Corrupt Organizations Act ("RICO"), 18 U.S.C. §§1961-1968. In 1985, the Court first addressed the "pattern of racketeering" element of a RICO offense. Sedima, S.P.R.L. v. Imrex Co., 473 U.S. 479, 493, 497, 105 S.Ct. 3275, 3283, 3285 (1985). Four years later, the Court again addressed the "pattern" issue, recognizing "the plethora of different views expressed by the Court of Appeals since Sedima demonstrates . . . developing a meaningful concept of 'pattern' has proved to be no easy task." H.J. Inc. v. Northwestern Bell Telephone Co., 429 U.S. 229, 109 S.Ct. 2893, 2899 (1989).

both an example of a compilation not sufficiently original to warrant copyright protection (a "garden variety white pages") and contrasted that compilation with one sufficiently original to warrant protection. Such a ruling would provide clear guidance to the lower federal courts by enabling them, in effect, to determine whether the compilation before them is more like a "white pages" or a "yellow pages" directory.

CONCLUSION

For the reasons set forth above, West submits that the Court should grant BAPCO's petition and reverse the decision below.

Dated: December 28, 1993

Respectfully submitted,

James E. Schatz*
Bradley W. Anderson
Joseph M. Musilek
HEINS SCHATZ & PAQUIN
2200 Washington Square
100 Washington Avenue South
Minneapolis, MN 55401
(612) 339-6900
Counsel for West Publishing Company

*Counsel of Record